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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,462	09/08/1999	RICHARD C. GOSSWEILER III	D/99341Q2	8641

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EXAMINER

DONAGHUE, LARRY D

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 11/16/2004

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,462

Applicant(s)

GOSSWEILER ET AL

Examiner

Larry D Donaghue

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/22/2004 from the BPAI.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-9 are presented for examination.

2. In view of the decision of the BPAI, mailed 07/22/2004, the following action on the merits is presented.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,340,931. Although the conflicting claims are not identical, they are not patentably distinct from each other because both methods comprise substantially the same steps. The difference between this application and the 931 patent is the association with a network accessible document and the printing of said network accessible document within a determined duration present in claim 1 of the 931 patent. Although the method of this application is directed toward navigation and not printing (as the 931 patent's method is), it would have been obvious to modify the method of the 931 patent to provide navigational actions because both printing and navigation (such as displaying a text document or navigating to a particular point in a document) are digital services which may be offered through electronic tags (see Harrison et al. U.S. Patent No. 6,249,226, col. 9, lines 28-33).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, and 4 - 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Want et al., U.S. Patent No. 6,342,830 in view of Pulley et al., U.S. Patent No. 6,222,557.

7. As to claim 1, Want et al. teach a system for digital services comprising an electronic tag having a digitally readable identifier (col. 1, lines 66 - 67), an electronic tag reader configured to read the identifier of the electronic tag (col. 1, line 67 - col. 2, line 1), and a computing system connected to the electronic tag reader to provide digital

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services (col. 2, lines 2 - 5.) However, Want et al. does not teach that the system may be used to navigate N-space data sets.

8. Pulley et al. teach a method for navigating a three-dimensional data set (col. 2, line 66 col. 3, line 3), with the computing system generating at least one transitional point in N-space for output between a currently displayed start point and a target point referenced by the user (col. 1, line 64 - col. 2, line 2.)

9. Examiner adopts the reasoning for obviousness as set forth by the BPAI, decision mailed 07/22/2004, and is set forth below.

With respect to independent claim 1, Appellants argue, "[a]s in Lee [277 F.3d 1338], the Examiner of the application on Appeal has failed to establish that the references suggest the desirability of the invention disclosed in . . . claim 1." Appellants point out, "there are two scenarios by which one skilled in the art might be motivated to combine the disclosures of the '830 [Want] patent and '557 [Pulley] patent. The Examiner has not argued either of these. First, the Examiner has not shown that the '830 patent discloses or suggests in any manner navigation of any type of space." (brief, page 10). Appellants then argue, "[t]he combination of the two patents appears to be nothing more than hindsight reconstruction by the Examiner." Appellants also argue, "[t]he Examiner may also be of the position that the claimed invention in the present application would be obvious to try after reviewing the cited references. Obvious to try, however, is not the standard by which obviousness is determined under 35 U.S.C. § 103." (brief, page 11). We do not find Appellants' arguments persuasive.

With respect to the issue of "hindsight motivation," we find that no hindsight was needed to construct the combination of the Want and Pulley patents, as the motivation to combine was clearly present in the references. As Appellants noted themselves, one such motivation would be if the Want patent "discloses or suggests in any manner [, the] navigation of any type of space." Such is found at column 9, lines 30-33. Want states, "[t]here is an enumerated list of such actions - display a Web page, display a text document, display a date in a calendar, go to a certain location in a document, and so forth." We find that going to a certain location within a document is "navigation" within "a type of space." Therefore, Want provides a specific motivation to combine the Want and Pulley references.

In addition to this specific suggestion, we remind Appellants that the Examiner may find a motivation to combine prior art references in the nature of the problem to be solved. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004); Also *Pro-Mold & Tool Co. v. Great Lake Plastic Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630; *In re Huang*, 100 F.3d 135, 139 n.5; 40 USPQ2d 1685, 1688 n.5 (Fed. Cir. 1996). Want teaches that their system provides a powerful tool for maintaining a bridge between the real and virtual worlds, and that the system allows the performance of user selected digital services. See Want at column 1, lines 54-61. Pulley at column 1, lines 19-20, teaches "various rendered 2D or 3D objects . . . can represent stocks, bonds, or other items of interest," and at lines 36-38, 45-46, and 59-60, "[i]t is typically desired by users . . . to view the landscape from more than one single fixed viewpoint and/or distance," "zooming . . . allows a user to: choose to observe a single object," and "the visualization system responds to input from the user to change the desired viewpoint accordingly." That is, Pulley is directed to solving the problem of providing a bridge between the real and virtual worlds and allowing the selection of digital services. We find that the nature of the problem to be solved also provides more than sufficient motivation to combine the prior art references.

We turn now to the issue of "obvious to try." Appellants are correct that "obvious to try" has long been held not to constitute the test for obviousness. However, equally it has long been held not to constitute the test for nonobviousness. *In re O'Farrell*, 853 F.2d 894, 903-904 (Fed. Cir. 1988), discusses this point: It is true that this court and its predecessors have repeatedly emphasized that 'obvious to try' is not the standard under § 103. However, the meaning of this maxim is sometimes lost. Any invention that would in fact have been obvious under § 103 would also have been, in a sense, obvious too try. The question is: when is an invention that was obvious to try nevertheless nonobvious?

The admonition that 'obvious to try' is not the standard under § 103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. *E.g.*, *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278; *Novo Industri A/S v. Travenol Laboratories, Inc.*, 677 F.2d 1202, 1208, 215 USPQ 412, 417 (7th Cir. 1982); *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981); *In re Antonie*, 559 F.2d at 621, 195 USPQ at 8-9. In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hybritech, Inc. v. Monoclonal*

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Antibodies, Inc., 802 F.2d 1367, 1380, 231 USPQ 81, 90-91 (Fed. Cir. 1986), cert. denied, --- U.S. ---, 107 S.Ct. 1606, 94 L.Ed.2d 792 (1987); **In re Tomlinson**, 363 F.2d 928, 931, 150 USPQ 623, 626 (CCPA 1966). Neither of these situations applies here.

Obviousness does not require absolute predictability of success. Indeed, for many inventions that seem quite obvious, there is no absolute predictability of success until the invention is reduced to practice. There is always at least a possibility of unexpected results, that would then provide an objective basis for showing that the invention, although apparently obvious, was in law nonobvious. **In re Merck & Co.**, 800 F.2d at 1098, 231 USPQ at 380; **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1461, 221 USPQ 481, 488 (Fed. Cir. 1984); **In re Papesch**, 315 F.2d 381, 386-87, 137 USPQ 43, 47-48 (CCPA 1963). For obviousness under § 103, all that is required is a reasonable expectation of success. **In re Longi**, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985); **In re Clinton**, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). The information in the Polisky reference, when combined with the Bahl reference provided such a reasonable expectation of success." The question before us is, "was there a reasonable expectation of success, or is the disclosure of Want merely an invitation to explore (to try) without any reasonable expectation of success?" We find that the sections of the sections of the Want and Pulley patents cited above, in addition to providing the motivation, also provide one of ordinary skill in the art a reasonable expectation of success. Appellants' statement at page 11, that "an electronic tag and tag reader would probably add to the expense and complexity of the '557 [Pulley] patent," is not persuasive. Expense and complexity are not determinative. What is relevant is "reasonable expectation of success," and we find that it is present.

10. As to claim 2, Pulley et al. teaches that the data set is a graphical data set (col. 3, lines 4 13.)
11. As to claim 4, the combination of Want et al. and Pulley et al. teach the invention substantially as claimed with respect to claim 1. However, the combination of Want et al. and Pulley et al. does not teach that the electronic tag is premarked.
12. Want et al. teaches that tags may be placed on objects such as a sheet or a card (col. 2, lines 11 - 12.) One of ordinary skill in the art would have been able to infer that cards, such as credit cards, are premarked. Credit cards, for example, have the owner's name and card number stamped on them.
13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Want et al. in view of Pulley et al. to make Want et al.'s generic card a credit card premarked with the owner's name and card number because premarking the tags would allow a user to easily identify the meaning or purpose of a tag without needing to use the tag reader.
14. As to claim 5, the combination of Want et al. teaches a surface of sufficient size and shape so that at a future time the user may make an annotation on the surface (col. 11, line 60, see BPAI Decision pages 14-15, section V).
15. As to claim 6, Want et al. teaches that the electronic tag is read by the tag reader through a wireless connection (col. 7, lines 38 - 41.)
16. As to claim 7, Want et al. teaches that the wireless connection operates at radio frequencies (col. 7, lines 38 - 41.)
17. As to claim 8, Want et al. teaches that the wireless connection is infrared (col. 7, line 45.)

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18. As to claim 9, Want teaches a method comprising the steps of first reading a first electronic tag having a digitally readable identifier with an electronic tag reader, with the digital identifier triggering a default action (Figures 6 and 7, also col. 14, line 62 - col. 15, line 19); and second reading a second electronic tag having a digitally readable identifier with an electronic tag reader, with the digital identifier triggering a second default action (Figures 6 and 7, also col. 15, lines 19 - 35.) However, Want et al. does not teach that either default action is a navigational action.

19. Pulley et al. teaches that the action may be a navigational action (col. 6, lines 12 - 14.)

20. See paragraph 9, for motivation to combine.

21. Claim 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Want et al. (6,342,830) in view of Card et al. (5,847,709).

22. As to claim 1, Want et al. teach a system for digital services comprising an electronic tag having a digitally readable identifier (col. 1, lines 66 - 67), an electronic tag reader configured to read the identifier of the electronic tag (col. 1, line 67 - col. 2, line 1), and a computing system connected to the electronic tag reader to provide digital services (col. 2, lines 2 - 5.) However, Want et al. does not teach that the system may be used to navigate N-space data sets.

23. Card et al. teach a method for navigating a three-dimensional data set (col. 3, lines 2-5) with the computing system generating at least one transitional point in N-space for output between a currently displayed start point and a target point referenced by the identifier (col. 9, lines 37-40.)

24. It would have been obvious to one of ordinary skill in the art at the time the invention in view of the express motivation of Want et al. and since motivation to combine may be found in nature of problem to be solved, leading one of ordinary skill in the art to look to references relating to possible solutions to that problem.

25. Want et al. states, "[t]here is an enumerated list of such actions - display a Web page, display a text document, display a date in a calendar, go to a certain location in a document, and so forth." Therefore, going to a certain location within a document is "navigation" within "a type of space." Therefore, Want et al. provides a specific motivation to combine the Want et al. and Card et al. references.

Further Want et al. teaches that their system provides a powerful tool for maintaining a bridge between the real and virtual worlds, and that the system allows the performance of user selected digital services. See Want et al. at column 1, lines 54-61. Card et al. at column 2, line 66 - column 3, line 14, teaches "A three dimensional document workspace for interacting with large numbers of document objects is disclosed. The document object is a graphical representation of an individual document or a document collection. The document workspace has been implemented for use to display and interact with documents, typically web pages, that have been downloaded from the World Wide Web. However, the document workspace is also suitable for use to display documents or document collections obtained from other sources (e.g. from a CD-ROM). Document collections are typically in the form of WebBooks or piles. WebBooks are document collections that are represented to a user using a book metaphor. A pile is a representation of a document collection that resembles a pile of paper contained in a paper tray. A pile is created by moving one document object on to another document object." That is, Card et al. is directed to solving

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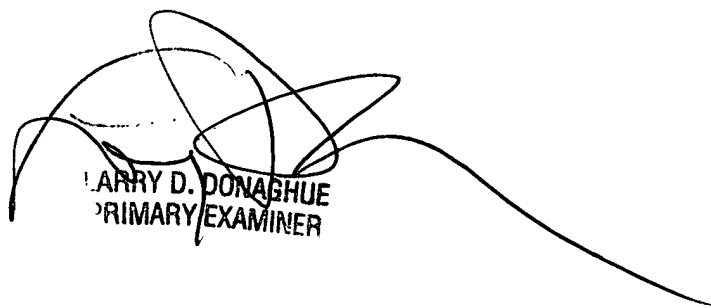
the problem of providing a bridge between the real and virtual worlds and allowing the selection of digital services. The nature of the problem to be solved also provides more than sufficient motivation to combine the prior art references.

26. As to claim 3, Card et al. teaches the data set is a document data set.

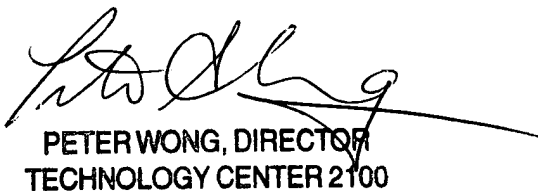
27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D Donaghue whose telephone number is 571-272-3962. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LARRY D. DONAGHUE
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